

No. 55.

IN THE

UNITED STATES CIRCUIT COURT OF APPEALS
FOR THE NINTH CIRCUIT.

CONSOLIDATED PIEDMONT CABLE COMPANY,
APPELLANT,
v's.

PACIFIC CABLE RAILWAY COMPANY,
APPELLEE.

BRIEF OF APPELLANT.

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BRIEF OF APPELLANT.

This appeal was taken from an interlocutory decree entered in the Circuit Court of the United States in and for the Northern District of California, wherein it was adjudged and decreed that the appellant herein (respondent below) had infringed upon the letters patent of the appellant (complainant below).

The letters patent sued upon were granted to Henry Root on July 12th, 1881, for an Improved Tension Apparatus for Cable Railways, and duly assigned to the appellee. The patent contains two claims, which are as follows:

“ 1. A tension and compensating apparatus for railway
“ cables, consisting of the cable pulley A having its axis jour-
“ naled upon the movable car C, and the chains F and weight
“ H, in combination *with the rails or timbers E upon which the*
“ *car travels, mounted upon a frame I, which moves upon a second-*
“ *ary track J, substantially as and for the purpose herein de-*
“ *scribed.*”

“ 2. The car C, moving upon the rails E and supporting the
“ cable-pulley A, the weight H, and chain F, and the rails E,
“ moving upon a secondary tramway J, in combination with the
“ operating tackle and the holding racks and pawls, substan-
“ tially as herein described.”

The Court has by its interlocutory decree found that both claims of the patent are valid, and that both claims have been infringed by the appellant.

The defenses relied upon are twofold:

First, That the patent in view of the prior state of the art is void, and

Second, That the appellant has not infringed upon either claim of the letters patent.

The appellant assigns the following seven errors as having been committed by the lower Court (Record, pages 43 and 44):

“ 1.

That the Circuit Court of the United States for the Northern District of California erred in holding that the appellant herein infringed upon the first claim of the letters patent sued upon.

2.

That the said Court erred in holding that the appellant herein infringed upon the second claim of the letters patent sued upon.

3.

That the said Court erred in holding that the alleged infringing tension apparatus contained the combination called for in the first claim of appellee's patent, inasmuch as the evidence showed that the secondary track called for by said claim was not in appellant's tension apparatus.

4.

That the said Court erred in holding that the alleged infringing tension apparatus contained the combination called for in the second claim of appellee's patent.

5.

That the said Court erred in overruling the objection of the appellant to the following question asked the witness Arthur F. L. Bell on cross-examination:

“ X.-Q. 4. Now, looking at complainant's ‘ Exhibit C ’ which is the model of the defendant's tension apparatus, and observing the framework or car which is marked ‘ I ’ on that model, and which carries the pulley over which the weight suspending chain passes, tell the Court what different function, if any, it has in the mode of operation of defendant's tension apparatus, from the function of the movable framework of complainant's apparatus, which consists of the connected timbers ‘ E ’ and ‘ I ? ’ ”

6.

That the said Court erred in sustaining the first and second claims of appellee's patent sued upon.

7

That the said Court erred in ordering an interlocutory decree against appellant, ordering, adjudging and decreeing that the appellee is entitled to an injunction, and decreeing a reference to the Master in Chancery of said Court for an accounting.”

The first four errors assigned, inasmuch as they relate to the question of non-infringement, may be considered together;

and in so considering them, we think the learned Judge of the lower Court entirely ignored the distinction which has been so frequently pointed out by the United States Supreme Court, between primary and secondary patents, in the application of the doctrine of equivalents.

The patent in this case is for some of the details of a tension apparatus. As the patent states upon its face (Record, page 37): "The usual method for keeping tension upon the cable is "to pass it around large pulleys at one or both ends, and these "pulleys are mounted upon trucks. A chain passes from the "rear end of the truck over a stationary pulley, and is at- "tached to a heavy weight within a pit, and this produces the "required tension."

This usual method was, of course, no part of the invention, although it comprises a very large part of what is shown in the patent and used by the patentee. It does not purport to be any part of the invention and is not covered by the claims of the patent. Yet it is the most important part of the apparatus used by the patentee as described in the patent. This part of the apparatus, which is used by the patentee but is not part of his invention, is exactly the same as the cable pulley A of the patent with the car C, the chain pulley G, the chain F, and the weight at the end of the chain. All of these things were old. It appears that the weight would, at some time, if the cable stretched enough, reach the bottom of the pit in which it hung. It became necessary, or at least convenient, therefore, to take up the slack of the chain which carried the weight in order that the chain might continue to pull on the cable pulley and keep the cable taut. To accomplish this would hardly seem to require a very great amount of invention. There were two ways of doing it which it would seem any ordinary mechanic might adopt without the exercise of any invention whatever. One very apparent way would be to draw the chain backwards until it had raised the weight as high as desired and then hitch the chain to the cable pulley car several links shorter than it was before. This was simply shortening the chain. This method would not, however, enable the patentee to obtain any patent for two reasons. One of these reasons was that so obvious a method would not be patentable at all; and the other reason was that William Eppelsheimer had already taken out a prior patent, dated August 16th, 1877 (Record, page 39), for shortening the chain, or rather a rope, which he used instead of the chain, and which amounted to precisely the same thing, and in which prior patent Mr. Eppelsheimer had shown a drum with ratchet and pawl for winding up the rope on which the weight hung and thus keeping the weight above the bottom of the pit all the while. In this arrangement the rope or chain

pulley was stationary and did not require to be placed on a moving car of any kind. Mr. Eppelsheimer's patent also contained an arrangement by which the action of the apparatus would automatically keep the rope wound and the weight suspended above the bottom of the pit. Although Mr. Eppelsheimer's patent showed the combination of the cable pulley car with the weight and rope and rope pulley and drum on the cable pulley car for winding up and shortening the rope, the combination of these devices was not claimed in his patent and such combination has always been public property. The appellant could have used that combination without infringing on any patent whatever. As Mr. Eppelsheimer's patent showed a method of shortening the rope and was issued between three and four years before Mr. Root applied for his patent he must of necessity adopt some other method of keeping up the weight, other than shortening the rope or chain if he desired to have any patent on any method of his own.

Another equally apparent method of taking up the slack of the chain would be to remove the chain cable pulley to a greater distance from the cable pulley car. It would certainly require no invention for the same mechanic who fixed the relative distances between the cable pulley car and the chain cable pulley, in the first instance, to again move the chain pulley as far from the cable pulley car as he fixed it in the first instance. Of course, as the cable stretched, the horizontal part of the chain between the cable pulley car and the chain pulley would keep shortening and the perpendicular part of the chain would keep lengthening until the weight might reach the bottom of the pit. By restoring the parts to their original relative positions the apparatus would again be in working order. These original relative positions of the cable pulley car and the chain pulley would be accomplished by moving the chain pulley as far from the cable pulley car as it was in the first instance. As these relative positions were fixed in the "usual method" that existed prior to the invention, there could be no invention in doing the same thing over again. We think we may safely say further that it could not call for any exercise of the inventive faculty to place the chain pulley on a car and move it by pulling the car backwards when it became necessary to move the chain pulley further from the cable pulley car. We know of no more common or ordinary method of moving things than to place them on a car and pull the car along. It was the very plan adopted in the "usual method" already in existence for moving the cable pulley and making it take up the slack of the cable. The cable pulley was mounted on the car C, and the car was pulled backwards by the weight at the end of the chain, which passed over the chain pulley. The above was the plan

adopted by the appellant. Instead of being drawn backwards by the chain and weight the chain pulley car is drawn backwards by the more common appliance of pulley and tackle.

One point which we make is, that there is nothing patentable in what the appellant uses, and therefore the appellee's patent cannot legally be construed so as to cover an apparatus that had nothing in it that was patentable.

Whatever method Mr. Root might adopt, it was certain that he must be limited to the means which he adopted, since the entire result of keeping the cable taut was already accomplished by the "usual" tension apparatus described in the appellee's patent, and by the apparatus shown and not claimed in Mr. Eppelsheimer's prior patent. This accomplished result, as well also as means for accomplishing it, were already public property. All that Mr. Root could do, therefore, was to find out some new means for accomplishing the same result.

Mr. Root got up the contrivance which is shown in the patent, and obtained the patent for certain combinations which were contained therein. In this apparatus Mr. Root has his cable pulley on top of a sliding car. The sliding car slides upon the bottom tracks, which are called in the patent "secondary tracks;" and he runs his cable pulley car upon the upper rails E which are placed at the top of the sliding car. In this method he is obliged to have, or at least he does have, an extra amount of framework built into the sliding car, and this extra framework he has made an element in the combination of his first claim. The upper set of rails E he has made an element in the combination of both his claims. The appellant does not have one car mounted upon another car, and it does not have two sets of tracks. It uses the main bottom track only, and has no use for any other. It has two cars on the same general track. It does not have either the "frame I", or the "rails E", which are elements of the claims of the patent sued upon.

In the drawings of appellee's patent are shown drawings of parts which serve as bumpers, and the evidence shows that the rods which pass loosely through the two cars of the appellant also serve as bumpers. The patent, however, does not say a word about those bumpers, nor does it make any claim to them in any way, shape or manner, either directly or indirectly. Those bumpers are, therefore, no more in the patent than they would be if they were not shown in the drawings at all. A complainant, if he recovers at all in a patent case, must recover upon his patent alone. His patent covers nothing except what its claims cover. Everything described in a patent and not covered by the claims of the patent is, in point of law, conclusively presumed to be no part of the patentee's invention, and is not covered or protected by the patent.

As a pertinent authority bearing upon this proposition, we cite the case of *Mahn vs. Harwood*, 112 U. S., where the Supreme Court says, beginning near the bottom of page 360:

“The taking out of a patent which has (as the law requires it to have) a specific claim, is notice to all the world, of the most public and solemn kind, that all those parts of the art, machine or manufacture set out and described in the specification and not embraced in such specific claim, are not claimed by the patentee—at least not claimed in and by that patent. If he has a distinct patent for other parts, or has made application therefor, or has reserved the right to make such application, that is another matter not affecting the patent in question. But so far as that patent is concerned, the claim actually made operates in law as a disclaimer of what is not claimed; and of all this the law charges the patentee with the fullest notice.”

Substantially the same thing was said by the Supreme Court in the case of the Corn Planter patent, 23 Wallace, on pages 224 and 225. The Court there says:

“Where a patentee, after describing a machine, claims as his invention a certain combination of elements, or a certain device, or part of the machine, this is an implied declaration, as conclusive, so far as that patent is concerned, as if it were expressed, that the specific combination or thing claimed is the only part which the patentee regards as new. True, he or some other person may have a distinct patent for the portions not covered by this; but that will speak for itself. So far as the patent in question is concerned, the remaining parts are old or common and public.”

The foregoing language was quoted by authority in the case of *Rowell vs. Lindsay*, 113 U. S., pages 101 and 102.

See also *Merrill vs. Yeomans*, 94 U. S., pages 573 and 574.

Miller vs. Brass Co., 104 U. S., on page 352.

The bumpers shown in the drawings of the patent are not claimed either in combination or otherwise, and are not even described as any part of the patentee's invention either in combination or otherwise. They are therefore no more to be taken into consideration than they would be if they were not shown in the drawings or mentioned in the evidence.

As before remarked when we take from the description of the specification what is affirmatively declared to be old, that is, what the patent calls the “usual method” for keeping the tension upon the cable by passing it around pulleys at one or both ends, which pulleys are mounted upon trucks, and having a chain pass from the rear end of the truck over a sta-

tionary pulley with a heavy weight attached to it; and when in addition to this we also take from the drawings and specifications what is shown and not claimed as any part of the invention, such as the bumpers, the gipsy, etc., we find that the only things left are the special combinations of the two claims, which combinations are used solely for the taking up of the slack of the chain and nothing else.

The motions made are simply those which are made in the using of ordinary derricks. The result accomplished is simply that of lifting the chain so that its lower end with the weight attached thereto shall not reach the ground below. This result was one of such ordinary accomplishment in the ordinary methods of lifting and suspending weights from the time whence the memory of man runneth not to the contrary, that it certainly did not require much in the way of invention to accomplish it. The ingenuity required was not as much in finding means to accomplish the result, but in finding any means which had not already been in common use for a thousand years.

The bumpers not being described as any part of the invention and not being mentioned in the claims at all are out of the case.

Looking further into the claims we find that they are both claims for combinations only. Considering the nature of the invention (if there is any invention) which is for nothing except the new means of accomplishing an old and very ordinary result, that of raising a weight at the end of a chain and keeping it suspended, and it would be strange if any claim could be carved out of the description in the patent other than a claim for a new combination of devices used. None of the devices used are in and of themselves new. Tracks, both original and secondary, pulleys, weights, chains used for lifting weights, pulleys and blocks and other devices connected with the patented apparatus have each and all been in common use from time immemorial. While this fact would not prevent the making of a new combination or a new arrangement of the devices that might be patentable, it would prevent their being used in any other way as a new invention except in a new combination, or unless they were so combined as to make a new kind of machine which is not the case here. The claims are for new combinations only.

Being for combinations and nothing else the claims are subject to the rules of construction which are applied to combination claims, and one of the most elementary of these rules is, that a combination is an entirety, and every other combination of any number of the same elements which does not include the whole of the devices named in the patented combination is not

the same combination. The doctrine of mechanical equivalents applies to new combinations which for the first time produce a new result, or which produce an old result by operating upon some new mechanical principle, and when one of the devices or elements of a combination is left out and another device supplied in its place which performs substantially the same service it is the same thing as though the original device was used. It is still the same combination.

As we understand the law, whenever the Court allows the doctrine of mechanical equivalents or substitutes to be applied to combination claims and construes a substituted device to count the same as though it was the original device called for by the claim, it is giving the claim a liberal construction, but that in cases where the invention consists only in omitting from an existing combination one of the devices and substituting a different device for the one omitted, the patent will be given a strict construction and will not be allowed to cover mechanical equivalents, since doing so would make the older combination an infringement of the later patent. This point is beautifully illustrated in the case of *McCormick vs. Talcott*, 20 Howard, 402. In that case the patent was for what is called a divider in a reaping machine. A part at least of what was claimed to be an infringement was older than the patented invention. The Supreme Court in referring to this on page 407 of the report, uses the following language:

“Defendant does not support his reel by posts, as was done by McCormick. He uses the horizontal reel-bearer connected by a frame with the hinder part of the machine. This device for supporting the reel was invented and used many years before McCormick’s first patent of 1834. It had no reel-post situated as in his patent, and encountered none of the evils remedied by the change in its position. This attempt to treat the earlier and better device used by defendant as an infringement of a later device to obviate a difficulty unknown to the first, is an application of the doctrine of equivalents which needs no further comment.”

This entire case of *McCormick vs. Talcott* is a standard authority used by all the text writers as such. It is cited by the Supreme Court in *Morley Machine Co. vs. Lancaster*, 129 U. S., at the bottom of page 273. From pages 272 to 283 in the last mentioned case is a very full citation of authorities and rules for the construction of patents made by the Supreme Court in cases where the invention was of a primary character and the rules of liberal construction were applied.

Upon these primary inventions see also Walker on Patents, Sections 359 to 368.

The scope of the patented invention in this case is limited,

and the Court should not give to the patent the liberal construction which applies to primary inventions. The stubborn fact exists that the patent has but two claims and both claims are for combinations of devices and nothing else. The stubborn rules for the construction of combination claims must therefore prevail and every element named in each respective claim, or a mechanical equivalent of it must be found in the appellant's apparatus or the patent is not infringed.

The patentee takes up the slack of the weight chain by moving forward the chain pulley over which the chain passes. This increases the length of that part of the chain which is in a horizontal position, and lessens the length of that part of the chain which is in a perpendicular position. The appellant does the same thing. This method differs from that of Mr. Eppelsheimer. Mr. Eppelsheimer had a stationary chain pulley and when he wound up the chain on the drum it shortened both the horizontal part of the chain and also the perpendicular part of the chain. The raising of the weight in both cases resulted from shortening the perpendicular part of the chain. The differences between Eppelsheimer's and the patentee's method were unimportant. The result of raising the weight was the only result to be accomplished and this result was accomplished in both instances.

The patentee constructed his apparatus with the lower tracks J for the lower mechanism of the combinations covered by his claims. Upon these lower tracks he built a sliding frame or sliding car upon which he mounted his chain pulley. Upon this sliding frame he also mounted the rails E as tracks for the cable pulley car to run upon, and upon these upper rails he mounted the cable pulley car. Taekle and blocks were added which are substantially alike in both the patented and in the appellant's apparatus. That the general operation of the appellant's apparatus is substantially the same as that of the patent is not denied. That the appellant's apparatus infringes the patent is most emphatically denied.

The claims of the patent include as one of their elements the rails E. These rails, we assert, are not in the appellant's apparatus nor are any equivalents or substitutes of them there. The lower tracks J are also elements in both of the patent claims. These are in the appellant's apparatus. To infringe the claims or either of them there must be found in the appellant's apparatus *both the upper rails E and also the lower rails J, because both sets of rails are in each one of the claims of the patent.*

The first claim calls for the "rails or timbers E, upon which the car travels, mounted upon a frame I, which moves upon a secondary track J," etc.

The second claim calls for "The car C, moving upon the rails

*E, * * * moving upon a secondary tramway J, in combination,"* etc.

By the very terms of these claims there must be one set of rails which move upon the lower stationary set of rails. There must be not only two sets of rails, but they must be so arranged that the upper set must move upon the lower set. Unless, therefore, there can be found in the appellant's apparatus one set of rails or the equivalent of that set of rails, moving upon the lower set of rails, there is no infringement.

In order to see what might be an equivalent of the upper set of rails, it is essential to examine the description of those rails and see what office they perform in the combination. The specifications of the patent say (Record, page 38): "The wheel A has its shaft journalled in boxes upon the framework of a car C, which is provided with wheels D. These wheels are flanged and run upon rails or timbers E," etc.

"The rails or timbers E are united to the framework I, which rests upon long timbers J," etc.

In the drawings, the rails E are shown as tracks upon which the car which carries the cable pulley rests. The rails E are mounted upon the framework I, and serve as tracks for the cable pulley car to rest and move upon, *and they serve no other purpose whatever*. If the rails E were removed from the framework I, shown in the drawings, the framework would be left without tracks for the cable pulley car, but it would not be otherwise affected. The timbers on which the chain pulley rests would still be there, and the sliding framework I would still be there. Nothing would be left unsupported except the car C. As the only result that would be effected by the removal of the rails E would be the leaving of the car C without tracks, it follows that the rails E are tracks for that car, and they are nothing else.

If, however, the rails E were to be removed as suggested *the lower rails J would still remain*. By cutting away the back part of the frame work I, or by carrying the frame work further forward out from under the car C, the car would be let down upon the lower tracks J, and then the apparatus would have all the elements that are in the defendant's apparatus. There would still remain the lower track, the cable pulley car, and the chain pulley sliding car. There would still remain all the parts that can be found in the appellant's apparatus, the principal difference being that the chain pulley car would be a sliding car instead of rolling upon wheels. The appellant's chain pulley car being upon wheels instead of sliding makes it that much different from the patented devices. If this constitutes any material difference it is a difference that gets that much away from an imitation, and therefore that much away from an in-

fringement. We do not claim that the car on wheels constitutes any material difference from the sliding car, but rather that it is an illustration of what constitutes a mechanical equivalent. Making the above changes in the patented apparatus takes out from it the rails E, but does not put anything back to take their place.

We think the foregoing discussion fairly illustrates that the rails E are not in the appellant's apparatus at all. That the appellant has no secondary track of any nature or kind for its cable pulley car, but that in using the lower track for both cars they dispense entirely with the tracks E, and do not supply their place with any equivalent. If this is so there is no infringement, as we will show by the authorities.

It should be noticed that the length of the sliding frame work of the patent is long enough to carry both the cable pulley car C, and also the chain pulley sliding frame or car. If the frame work was all cut away from under the cable pulley car C, so that the latter came down and rested upon the lower tracks J, the length of the tracks J would not need to be increased. It requires the same length and amount of the lower tracks J for the sliding frame of the patent as it does for the two cars of the appellant. The upper tracks E do not take the place of the tracks J in the least degree in the patent, nor does the lower tracks of the appellant's apparatus take the place of the upper tracks E, of the patent. By this we mean that the tracks J are not made any longer nor increased in any way by the appellant on account of using them for both the cars; nor are the tracks J made any less in length or in any way diminished because the patentee uses the upper track for the car C to run upon. In other words the appellant makes the lower tracks do all the work which the two sets of tracks of the patent perform, and thereby gets rid of the upper rails or timbers E, which constitute one of the essential elements of each one of the combinations which are covered in the two claims of appellee's patent. So long as the rails E are not in the appellant's apparatus, there is one element of the patented combinations wanting and there is no infringement.

But two witnesses were examined in this case, William H. Smyth on behalf of the appellee, and A. F. L. Bell on behalf of the appellant.

The cross-examination of the witness Smyth (Record, page 15), shows that the rails E are not in the appellant's device: see the following testimony:

"X.-Q. 12. Now, how many sets of tracks on which the cars run or slide do you find in the defendant's device?

"A. One set. There are four tracks, but answering your question as I understand it, there is only one set of tracks.

“ They are continuous so that they form tracks both for the carriage “ C ” and the chain-wheel carriage.

“ X.-Q. 13. There is but one set of tracks in the defendant’s machine, is there?

“ A. With that explanation, yes.

“ X.-Q. 14. You do not find both the tracks “ E,” and also the secondary tracks “ J ” in the defendant’s machine, do you?

“ A. I find them combined in one. I find that both carriages work on the same track.

“ X.-Q. 15. In the patented apparatus the rails “ E,” on which the car “ C ” moves are placed directly over the secondary rails “ J ” mentioned in the patent, are they not?

“ A. Yes, sir.”

See also the following testimony of the witness Bell (Record, pages 19 and 20):

“ Q. 22. Referring now to the two claims of the patent sued upon, No. 244,147, please describe what the rails or timbers “ E ” are, and also what the secondary track “ J ” is, as found in the model “ Exhibit B?”

“ A. The timber “ E ” is the part of a framework of a large truck, and forms or supports the rails upon which the tension-carriage “ C ” runs. These timbers “ E ” also form part of the truck upon which the chain-sheave is mounted, which supports the tension-chain and counter-weight.

“ The secondary tracks “ J ” are supports for guides for the truck which is formed by the framework “ E ” and “ I,” and is supposed to run the full length of the engine house, or that part of the building which is set aside for stretching the cable.

“ Q. 23. In the apparatus which the defendant uses, or has used, is there or has there been any secondary track?

“ A. There has not.

“ Q. 24. Has the defendant had or used any stretching or tension apparatus in which there was one track placed above another track?

“ A. No.

“ Q. 25. Has the defendant used any other apparatus which had any framework between any upper and lower, or original and secondary track corresponding in any way, shape or manner to the framework “ I ” mentioned in the claims of the patent sued on?

“ A. No.

“ Q. 26. Has the defendant used any tension apparatus in which there was any rails or timbers which corresponded to the rails or timbers “ E ” mentioned in the claims of the patent sued on?

“A. No.”

As is said in Walker on Patents, Sec. 349: The “omission of one ingredient of a combination covered by any claim of a patent, averts any charge of infringement based on that claim.”

See also—

- Prouty vs. Ruggles*, 16 Peters, 341.
- Eames vs. Godfrey*, 1 Wallace, 78.
- Case vs. Brown*, 2 Wallace, 320.
- Dunbar vs. Myers*, 94 U. S., 201 and 202.
- Fuller vs. Yentzer*, 94 U. S., 297.
- Rowell vs. Lindsay*, 113 U. S., 102.
- Shepard vs. Carrigan*, 116 U. S., 597–598.
- Sharp vs. Riessner*, 119 U. S., 636.
- Coolidge vs. McCone*, 2 Sawyer, page 576.
- Matteson vs. Caine*, 8 Sawyer, 498.
- Gould vs. Rees*, 15 Wallace, 187.

“A combination is an entirety. If one of its elements is omitted, the thing claimed disappears. Every part of the combination claimed is conclusively presumed to be material to the combination, and no evidence to the contrary is admissable in any case of alleged infringement. The patentee makes all the parts of a combination material, when he claims them in combination and not separately.”

Walker on Patents, Sec. 349.

- Vance vs. Campbell*, 1 Black, 430.
- Sargent vs. Lock Co.*, 114 U. S., 86.
- Shepard vs. Carrigan*, 116 U. S., 597 and 598.
- Yale Lock Co. vs. Sargent*, 117 U. S., 378.
- Brown vs. Davis*, 116 U. S., 249.
- Gage vs. Herring*, 107 U. S., 648.

Nor can the rails or timbers E, as a specific and essential element in appellee's tension apparatus, be read out of the claim at this time.

“Our law requires the patentee to specify particularly what he claims to be new, and if he claims a combination of certain elements or parts, we cannot declare that any one of these elements is immaterial. The patentee makes them all material by the restricted form of his claim.”

Water Meter Co. vs. Desper, 101 U. S., 337.

“The claims of the patent sued on in this case are claims for combinations. In such a claim, if the patentee specifies any element as entering into the combination, either directly by the language of the claim, or by such a reference to the descriptive part of the specification as carries such element

“ into the claim, he makes such element material to the combination, and the Court cannot declare it to be immaterial. It is his province to make his own claim and his privilege to restrict it. If it be a claim to a combination, and be restricted to specified elements, all must be regarded as material, leaving open only the question whether an omitted part is supplied by an equivalent device or instrumentality.”
Fay vs. Cordesman, 109 U. S., 420.

The rails or timbers E are described in the specification and shown in the drawings to be the rails or timbers upon which the wheels D of the upper car C run (Record, page 38), and they are specifically claimed in both of the claims of the patent. “ There is nothing in the context to indicate that the patentee contemplated any alternative ” for them.

Snow vs. Lake Shore Ry. Co., 121 U. S., page 630.

In this case no opinion has been rendered in the lower Court, other than to direct a decree in favor of the appellee, and we are therefore obliged to assume that the Court has taken the view of the appellee’s patent for which its counsel contended, namely, that the principle and mode of operation of the two tension devices are identical, and that the final result is the perpetual compensation and take-up of the cable slack without stopping the cable, and that, therefore, the appellant infringes. This proposition entirely ignores the law governing combination claims. It also ignores all the rules of law regulating the construction of secondary inventions and improvements made on prior and existing machines and devices. It is an elementary principle that the rules of law which relate to the construction of primary inventions are not the rules of law to be applied to the construction of improvements which have succeeded those inventions. In the case at bar, Mr. Root’s invention is not a primary invention in any sense of the term; his patent shows this, and in addition to that the appellant has introduced in evidence the Eppelsheimer patent, and the most that the appellee can now contend for its patent is that it is entitled to claim the specific combinations created, circumscribed and bound within the limits the patentee himself placed thereon, and by the prior state of the art. The patentee was not the first inventor of a tension apparatus; that, he specifically disclaims in his patent. He is not the first who created a perpetual compensator which was capable of taking up the slack without stopping the cable. Eppelsheimer accomplished the same thing in his patent of August, 1877. Nor was Root the first or original inventor of any of the separate elements which go to make up the combinations of the two claims of his patent. He received a patent for his combinations, as he placed and

arranged them, and he is bound by the limitations which he has himself imposed.

An inspection of the record in this case shows that it was the intention of the appellee to attempt to make its patent reach out and cover the appellant's device, not because the appellant's device, either in arrangement or combination, is covered by the claims of the patent sued upon, but upon the theory that the action was the same though the construction is different. The direct examination of the witness Smyth (Record, page 14) shows this, and the cross-examination of the witness Bell also shows that the purpose of his cross-examination was to prove both that the result obtained was the same and the mode of operation practically the same. This is why we objected to the question asked the witness Bell, and which is made the basis of our fifth assignment of error. This question is certainly objectionable, inasmuch as it calls for an opinion as to what function a certain device performs, and the mode of operation covered thereby, which is totally irrelevant and immaterial to the inquiry of infringement respecting combination claims.

We therefore contend that the Court erred both in allowing the question and in construing the claims of the patent sued upon.

If the patent of the appellee had been for a *primary invention*, then the appellant might be held to infringe because effecting substantially the same result in substantially the same way, or because the functions and mode of operation are substantially the same. But it does not follow that the same rule would hold between the patentee of a *secondary invention* and his alleged infringer.

“If the patentee be the original inventor of the device or machine called the divider, he will have a right to treat as infringers all who make dividers operating on the same principle, and performing the same functions by analogous means or equivalent combinations, even though the infringing machine may be an improvement of the original, and patentable as such. But if the invention claimed be itself but an improvement on a known machine by a mere change of form or combination of parts, the patentee cannot treat another as an infringer who has improved the original machine by use of a different form or combination performing the same functions. The inventor of the first improvement cannot invoke the doctrine of equivalents to suppress all other improvements which are not mere colorable invasions of the first.”

McCormick vs. Talcott, 20 How.. 405.

“ In such cases, if one inventor precedes all the rest, and strikes out something which includes and underlies all that they produce, he acquires a monopoly, and subjects them to tribute. But if the advance toward the thing desired is gradual, and proceeds step by step, so that no one can claim the complete whole, then each is entitled only to *the specific form of device which he produces*, and every other inventor is entitled to *his own specific form*, so long as it differs from those of his competitors, and does not include theirs.”

Railway Co. vs. Sayles, 97 U. S., 556.

The first inventor of a sewing machine might successfully maintain a suit for infringement against one who constructed a machine that would sew in “substantially the same way.” But the case of a second inventor, whose claim to inventive genius rests solely upon an alleged discovery of the beneficent operation of *old elements in combination*, would be determined according to altogether different rules, as will be seen from the cases last cited above.

The rule as to the application of the doctrine of equivalents, in the case of patents for combinations, all producing the same results, but different in their forms of combination, is stated in *Hill vs. Sawyer*, 31 Fed. Rep., 285: “The defendant’s rolls are not the rolls of the patent, and, although they produce similar results, they cannot be regarded as equivalents. This case, it is thought, belongs to that class of inventions where the doctrine of equivalents cannot be invoked to suppress improvements on a well known machine. Where change of form or combination only is involved, each inventor must be content with the structure described and claimed by him.” See also:

Tobey Furniture Co. vs. Colby, 26 Fed. Rep., 100.

And it must not be forgotten that the appellee in this case is indisputably in the position of the patentee of a secondary invention. Tension apparatus, accomplishing substantially the result accomplished by the tension apparatus of appellee, were known to the art before to the date of the appellee’s patent. He has not claimed in his patent to be the inventor of any specific element contained in his combinations. He only warned the public by his application for a patent, of his claims to *the combination*. And as we have seen in the Corn-Planter case, cited above, “Where a patentee, after describing a machine, claims as his invention a certain combination of elements, or a certain device, or part of the machine, this is an implied declaration, as conclusive so far as that patent is concerned as if it were expressed, that the specific combination

“ or thing claimed is the only part which the patentee regards “ as new.”

It is a rule of patent law that the inventor is bound by the claims which he makes, or accepts from the Patent Office, even when that office compels the applicant for a patent to modify the claims which he originally makes, as a condition of granting the patent. However meritorious the invention may be, and however much the inventor may be legally and morally entitled to a patent that will be a full protection to him for his invention, he yet owes something to the public. The law requires that he shall describe *and claim* his invention in distinct terms so that the public may know what the invention is which he claims. He must make his claims distinct and plain so that persons skilled in the art or mechanism to which the invention belongs may know when they are infringing and when they are not infringing. This is but a small requirement from the inventor. It is only just and reasonable to the public. The law says, and the Courts have decided that he must do it. The following authorities are very pointed upon this proposition:

Merrill vs. Yeomans, 94 U. S., pages 573 and 574.

Keystone Bridge Co. vs. Phoenix Iron Co., 95 U. S., 274.

Burns vs. Meyer, 100 U. S., latter part of the decision on page 672.

White vs. Dunbar, 119 U. S., latter part of page 51 and first part of page 52.

James vs. Campbell, 104 U. S., last half page 370.

The sixth assignment of error is that the Court erred in sustaining the first and second claims of the patent sued on.

The testimony in this case shows the existence of devices which for many years accomplished the same general results accomplished by the patent. It is admitted in the patent that such general results had been accomplished prior to the application for the patent, and the introduction of the Eppelsheimer patent further shows that the results which were accomplished in that patent were identically the same as those accomplished by Root in his patent. The only change which the patentee Root made was to put two cars, one on top of the other, to accomplish what Eppelsheimer had accomplished by the winding drum in his patent.

The witness Bell on his direct examination (Record, pages 17, 18 and 19), shows that no new result has been accomplished by what Root has done over what had already been shown in the Eppelsheimer patent. *The result obtained is exactly the same.* There is a weight held in suspension, the purpose of which is to keep a tension on the main cable. There is a car which

carries a pulley or sheave. There is a compensating device which takes up the slack without stopping the cable. The general characteristics of one are the same as the other.

To the same general effect is the testimony given on cross-examination (Record, pages 26 to 32).

The testimony of the witness Bell fairly shows when considered in connection with the patents introduced in evidence, that there is no patentable difference in the Root patent over what was already in existence at the time it was applied for. It also shows that what the appellant did was to formulate another and different way, which is not similar to either, to take up slack and to act as a perpetual compensator.

If we assume that there is anything new in what Mr. Root did above or beyond that which had already been done at the time of his application for a patent; it was the mere substitution of an equivalent device for that of Eppelsheimer; that is, he added a second car for accomplishing what the prior patentee had accomplished by means of his winding drum. That substitution however does not amount to a patentable difference, even though it might be said to be able to do the same thing in a better way. The patent in this case is justly subject to the criticism which was made by the United States Supreme Court in *Smith vs. Nichols*, 21 Wallace, at page 119, where it is said that:

“ A mere carrying forward, or new or more extended application of the original thought, a change only in form, proportions or degree, the substitution of equivalents, doing substantially the same thing in the same way by substantially the same means with better RESULTS, is not such invention as will sustain a patent. These rules apply alike, whether what preceded was covered by a patent or rested only in public knowledge and use. In neither case can there be an invasion of such domain and an appropriation of anything found there. In one case everything belongs to the prior patentee, in the other, to the public at large.”

This case has been cited numberless times with approval both in the Circuit and the Supreme Court.

The case of *Hill vs. Wooster*, 132 U. S., 701, is directly in point here. The Court there said:

“ It is not enough that a thing shall be new, in the sense that in the shape or form in which it is produced it shall not have been before known, and that it shall be useful, but it must, under the Constitution and the statute, amount to an invention or discovery.

See also *Burt vs. Erory*, 133 U. S., 349 and cases cited.

McClain vs. Ortmyer, 141 U. S., 419 and cases cited.

The seventh assignment of error is fully considered herein under the other heads.

We respectfully submit that the patent of the appellee is void and that the appellant has not infringed thereon.

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